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THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: David G. McCarthy :  
Title: Retractable Receptacle For : Examiner: B. Hammond  
Furniture :  
Serial No. 08/951,276 : Group Art Unit: 2833  
Filed: October 16, 1997 :

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MARK P. STONE Reg. No. 27,954

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APPEAL BRIEF

I. INTRODUCTION:

This is an appeal from the final rejection of Claims 1 - 20  
made by the Primary Examiner in the Official Action dated August  
31, 1999.

A Notice of Appeal was timely filed in the Patent &  
Trademark Office on December 2, 1999.

Appealed Claims 1 - 20 are reproduced in the Appendix of  
Appealed Claims, being filed concurrently herewith.

II. REAL PARTY IN INTEREST:

David G. McCarthy, the Applicant, is the real party in  
interest.

### **III. RELATED APPEALS AND INTERFERENCES**

Applicant and Applicant's counsel are unaware of any other appeals or interferences which will directly affect, or be directly affected by, or have a bearing on the Board's decision in the present Appeal.

### **IV. STATUS OF CLAIMS:**

Claims 1 - 20 are pending in the instant patent application. No claims have been cancelled, and no claims are allowed. The final rejection of Claims 1 - 20 made in the Official Action dated August 31, 1999 is being appealed.

### **V. STATUS OF AMENDMENTS:**

A Request For Reconsideration After Final Rejection was filed on November 1, 1999. This request presented arguments in support of the allowance of the claims, but did not seek to amend any of the finally rejected claims. In an Advisory Action dated November 16, 1999, the Examiner acknowledged that the Request For Reconsideration After Final Rejection had been considered, but maintained the final rejection of Claims 1 - 20.

### **VI. SUMMARY OF THE INVENTION:**

The present invention is directed to a receptacle for electronic or communications equipment mounted in standard furniture units, such as office conference tables. Referring to Figure 1 of the drawing, the top surface 8 of a table 4 has two square cutout openings 12 for receiving therein a receptacle unit

designated by reference numeral 22 (See page 8 of Applicant's specification). The receptacle 22 shown towards the left side of the table top is in a recessed position in which the top surface 24 of the receptacle is coplanar with the top surface 8 of the table. However, the receptacle 22 towards the right side of the table is shown in its extended position in which the top surface 24 of the receptacle is elevated above the top surface 8 of the table, thereby providing access to four sidewalls 26 of the receptacle 22. The sidewalls carry individual receptacles 32 for receiving connecting power cords from electrical and communication equipment on the table top, as for example the computer 14 and the telephone 16. (See Applicant's specification, page 9, first full paragraph through page 10, first paragraph). The receptacle unit 22 is itself connected to external power sources including electrical power lines and communication transmission lines (See Applicant's specification, page 11, lines 1 - 4).

When the receptacle unit 22 is in its extended position as shown to the right on the table top in Figure 1, power lines from equipment on the table top, as for example the telephones 16, are coupled to one of the individual receptacles 32 in one of the walls 26 of the receptacle unit 22. After one or more units of equipment are coupled to the receptacle unit, the receptacle is depressed into its retracted position as shown by the receptacle unit 22 to the left on the table top shown in Figure 1. A gap between the top 24 of the receptacle unit 22 and the periphery of

the square shaped opening 12 defined in the table top 8 provides clearance for cords connecting equipment on the table with the receptacle unit 22 so that the receptacle unit can be depressed into its retracted position with one or more cords received in the individual receptacles 32. Releasable locking means maintain the receptacle unit 22 in its retracted position, and resilient means are provided for biasing the receptacle unit 22 into its extended position when the locking means are released (See Applicant's specification, page 10, first paragraph through page 11, first paragraph).

In a further aspect of the present invention, a screen or brush on the periphery of the square shaped openings 12, or in the alternative, carried by the periphery of the top surface 24 of the receptacle unit 22, is provided to cover the gap space defined between the top surface 24 of the receptacle 22 and the top surface 8 of the table when the receptacle unit 22 is in its retracted position. In this manner, small articles are prevented from falling into the gap space when the receptacle unit 22 is in its retracted position (See page 9, last paragraph, lines 14 - 20 of Applicant's specification).

#### **VII. ISSUES ON APPEAL:**

The following issues are raised by Applicant in this Appeal:

a). Whether Claims 1 - 20 have been properly rejected under 35 U.S.C. Section 112, first paragraph, for the reasons relied upon by the Examiner at page 3, paragraph 5 of the final action dated August 31, 1999;

b). Whether Claims 1, 2, 6 and 16 are anticipated under 35 U.S.C. Section 102(b) by United States Patent No. 4,747,788, for the reasons relied upon by the Examiner at page 4, paragraph 7 of the final action dated August 31, 1999;

c). Whether Claims 19 and 20 are anticipated under 35 U.S.C. Section 102(b) by United States Patent No. 4,511,198 for the reasons relied upon by the Examiner at page 4, paragraph 8 of the final action dated August 31, 1999; and

d). Whether Claims 3 - 5, 7 - 15, and 17 - 18 are unpatentable under 35 U.S.C. Section 103(a) over United States Patent No. 4,747,788, for the reasons relied upon by the Examiner at page 4, paragraph 9 of the final action dated August 31, 1999.

A Request for Reconsideration After Final Rejection was filed on November 1, 1999. In an Advisory Action dated November 16, 1999, the Examiner acknowledged that the Request for Reconsideration was considered, but did not place the case in condition for allowance because "the prior art of record still applies to claims 1 - 20". It is unclear from the Advisory Action if the Examiner is still relying upon the rejection of

claims made in the final action under 35 U.S.C. Section 112, first paragraph. Applicant had addressed these formal grounds of rejection in the Request for Reconsideration After Final Rejection, and the Advisory Action makes no reference to these formal grounds of rejection. However, since the Advisory Action has not expressly withdrawn the formal grounds of rejection, Applicant will assume, for the purpose of this Appeal Brief, that the Examiner intended to maintain the formal grounds of rejection raised at page 3, paragraph 5 of the final Action dated August 31, 1999.

Applicant also notes that the final action dated August 31, 1999, at paragraphs 2 and 3, raises objections to the drawings. These objections are identical to the objections raised at paragraphs 2 and 3 of the Official Action dated June 10, 1999. Proposed drawing corrections overcoming these objections were filed with Applicant's response on August 9, 1999. The cover sheet of the final action dated August 31, 1999 states that the proposed drawing corrections filed on August 9, 1999 are disapproved, yet the body of the Official Action repeats the prior objections to the drawings but fails to provide any reasons why the proposed drawing corrections filed by Applicant on August 9, 1999 do not overcome all of the objections in the Official Action dated June 10, 1999 which were identically repeated in the final action dated August 31, 1999. However, since the drawing objections do not relate to the merits of the appeal but are

directed exclusively to matters of form, these objections are not issues which are required to be addressed in the instant appeal.

**VIII. GROUPING OF CLAIMS:**

The prior art rejection of Claims 1 - 5 and 7 - 15 will be argued together as a single group;

The prior art rejection of Claim 6 will be separately argued;

The prior art rejection of Claims 16 - 18 will be separately argued as a single group; and

The prior art rejection of Claims 19 - 20 and will be separately argued as a single group.

**IX. ARGUMENT:**

**A). REJECTION UNDER U.S.C. SECTION 112, FIRST PARAGRAPH**

At page 3, paragraph 5 of the final action dated August 31, 1999, Claims 1 - 20 have been rejected under 35 U.S.C. Section 112, first paragraph, as containing subject matter not described in the specification in such as way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In support of this rejection, the Examiner states:

"...There is a lack of written description for the following; "means for coupling said housing", means for resiliently biasing [*italicized*]; "means" for selectively displacing the receptacle unit; the "open top" of the housing; means for biasing the receptacle unit, locking means. And it is also unclear how the covering means are mounted to the top [underlined and italicized] of the receptacle unit and carried by the receptacle unit as it is being displaced."

Applicant respectfully submits that each of the structural elements to which the Examiner has objected is an element which will clearly be understood by a person having ordinary skill in the relevant art, in conjunction with applicant's specification and drawings. For example, expressions such as "means for coupling said housing", "means for resiliently biasing", "means for selectively displacing", and "locking means" are basic terms clearly within the knowledge of a person having ordinary skill in the art.

It is well established that a patent specification is enabling under 35 U.S.C. Section 112, first paragraph, if the disclosure is sufficient to enable a person having ordinary skill in the art to make and use the invention without undue experimentation. See, for example, DeGeorge v. Bernier, 226 USPQ 758 (Fed. Cir. 1985); Scripps Clinic & Research Foundation v. Genentech, Inc., 18 USPQ 2d 1001, 18 USPQ 2d 1896 (Fed. Cir. 1991). Moreover, it is well established that in determining if a specification is enabling, a specification need not disclose what is well known in the art. See, for example, Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481



(Fed. Cir. 1984); Hybritech Inc. v. Monoclonal Antibodies Inc., 231 USPQ 81 (Fed. Cir. 1986); Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 231 USPQ 649 (Fed. Cir. 1986); and Spectra-Physics, Inc. v. Coherent, Inc., 3 USPQ 2d 1737 (Fed. Cir. 1987).

Applicant respectfully submits that each of the terms and expressions questioned by the Examiner at paragraph 5 of the final action are terms and expressions describing conventional structure which will be readily understood by persons skilled in the art in conjunction with Applicant's specification. Such conventional structure is subject matter which is known in the art. Applicant therefore respectfully submits that the rejection of Claims 1 - 20 under 35 U.S.C. Section 112, first paragraph, is inappropriate and should be reversed. As previously noted at Section VII of this Brief, it is unclear if the Examiner intended to maintain this objection since no reference to it was made in the Advisory Action dated November 16, 1999.

**B). PRIOR ART REJECTIONS OF CLAIMS 1 - 5 AND 7 - 15**

In the final action dated August 31, 1999, independent Claim 1 and dependent Claim 2 were rejected as being anticipated by United States Patent No. 4,747,788. Dependent Claims 3 - 5 and 7 - 15 were rejected as being obvious over United States Patent No. 4,747,788. For the reasons discussed below, it is submitted that independent Claim 1 is patentable over the prior art applied to

reject it. Therefore, dependent Claims 2 - 5 and 7 - 15, each of which include all features of independent Claim 1, are allowable at least for the same reasons as independent Claim 1.

Independent Claim 1 is directed to a receptacle unit adapted to be mounted in an opening in the top surface of an article of furniture. The claim expressly recites that the top surface of the receptacle unit is planar with the top surface of the article of furniture when the receptacle unit is in its retracted position. The Byrne patent (U.S. Patent No. 4,747,788) discloses a slideable power cartridge designated by reference numeral 150, which is movable within an article of furniture. However, when the power cartridge 150 is in its retracted position, the outer perimeter of a collar 116 of a housing 108 is positioned above a work surface 104 so that the collar provides a supporting surface for the housing 108. Attention is invited to Figure 1 of the drawing and Column 6, lines 8 - 13 of the Byrne Specification. Therefore, the receptacle unit disclosed and illustrated by the applied prior art reference is not planar with the top surface of an article of furniture when the receptacle is in its retracted position.

It is well established that a rejection of a claim as being anticipated requires the Patent & Trademark Office to establish a strict identity of invention between the rejected claim and the applied prior art reference. It is inappropriate to reject a claim as being anticipated unless a single applied prior art

reference discloses all features of the claim, as arranged in the claim. See, for example, Connell v. Sear, Roebuck & Co., 220 USPQ 193 (Fed. Cir. 1983). Applicant submits, for the reasons discussed above, that there is no strict identity between the disclosure of United States Patent No. 4,747,788, and independent Claim 1 when all features of the claim are considered in the evaluation. Therefore, independent Claim 1 is patentable over the disclosure of the only prior art reference applied to reject it in the final action, and dependent Claims 2 - 5, and 7 - 15 are allowable at least for the same reasons as parent independent Claim 1.

C). PRIOR ART REJECTION OF CLAIM 6

In the final action dated August 31, 1999, dependent Claim 6 was rejected as being anticipated by the Byrne patent (U.S. Pat. No. 4,747,788). Dependent Claim 6 expressly recites means for resiliently biasing the receptacle unit (recited in parent independent Claim 1) into its extended position, and further recites cooperating releasable locking means opposing the means for resiliently biasing to retain the receptacle unit in its retracted position.

At page 4, paragraph 7 of the final action dated August 31, 1999, the Examiner refers to United States Patent No. 4,747,788 as disclosing "biasing means 180". Attention is respectfully invited to Column 10, Line 62 of the applied patent which

discloses that the elements designated by reference numeral 180 are bosses which are "squeezed" above grooves 148 to maintain a carriage 150 above a collar 116 of a housing 108. (See Column 10, Line 4 through Column 11, Line 52 of the Byrne Specification). Essentially, the bosses 180 are flexible stop elements, and are not means for resiliently biasing a receptacle unit into an extended position, as expressly disclosed and claimed by Applicant. The bosses 180 retain the carriage 150 in an extended elevated position only after the carriage has been moved into the extended position. The bosses do not displace the carriage from a retracted position and into an extended position as a result of a resilient bias applied by the bosses to the carriage. On the contrary, the carriage is manually moved into its extended position where it is thereafter retained in this position by the bosses.

Attention is also invited to the Abstract of the Disclosure of the Byrne patent, which states, in pertinent part:

"...In addition, a manually movable and slideable power carriage (150) is utilized to mount the receptacles (170). In response to manually exerted forces on the power carriage (150), the carriage can be extended upward into an open position..."

Thus, United States Patent No. 4,747,788 discloses a power carriage 150 which is manually movable relative to a fixed housing structure (108), and the disclosure of this patent does

not teach means for resiliently biasing a receptacle unit into any position relative to any fixed surface.

As discussed above with respect to independent Claim 1, a rejection based on anticipation is only appropriate if the Patent & Trademark Office establishes a strict identity of invention between the rejected claim and the applied prior art reference. The Examiner has failed to establish a strict identity of invention between the disclosure of United States Patent No. 4,747,788 and dependent Claim 6 for the reasons discussed herein.

D). PRIOR ART REJECTIONS OF CLAIMS 16 - 18

In the final action dated August 31, 1999, independent Claim 16 was rejected as being anticipated by the Byrne patent (U.S. Patent No. 4,747,788), and dependent Claims 17 - 18 were rejected as being obvious over the same applied reference. For the reasons discussed below, it is submitted that independent Claim 16 is allowable over the prior art applied to reject it, and dependent Claims 17 - 18 are allowable at least for the same reasons as parent independent Claim 16.

Independent Claim 16 is directed to an article of furniture having a receptacle unit mounted in an opening in the top surface of the article of furniture. The claim expressly recites that the receptacle unit, when in a retracted position, has a top which is planar with the top surface of the article of furniture.

The claim further recites that the receptacle unit has a plurality of sidewalls.

Applicant refers to the prior discussion of the Byrne patent made herein with respect to independent Claim 1. Applicant submits, for the reasons previously discussed, that the Byrne patent does not disclose a device in which the top surface of a receptacle unit is planar with the top surface of an article of furniture when the receptacle unit is in its retracted position.

Additionally, the Byrne patent discloses a movable power carriage 150 which defines a receptacle having only a single sidewall. It does not disclose a receptacle unit having a plurality of sidewalls as expressly recited in independent Claim 16.

Independent Claim 16 therefore expressly recites two features which are not disclosed by the applied prior art patent. Accordingly, there is clearly no strict identity of invention between the Byrne patent and independent Claim 16 when all features recited in the claim are considered in the patentability evaluation. Dependent Claims 17 - 18, which include all features of Claim 16, are allowable at least for the same reasons as the parent independent claim.

E). PRIOR ART REJECTION OF CLAIMS 19 - 20

In the final action dated August 31, 1999, independent Claim 19 and dependent Claim 20 were rejected as being anticipated by United States Patent No. 4,511,198 (Mitchell et al). The Examiner states that this reference discloses "...an article of furniture 10 with a top surface 12, a receptacle unit 30, with a top 50 and a receptacle 48, and a housing 50 mounted on the underside of furniture 10". [Final Action August 31, 1999, page 4, paragraph 8].

Applicant respectfully disagrees with the Examiner's assessment of the applied prior art reference. The housing 50 referred to in U.S. Patent No. 4,511,198 is a dielectric housing for a receptacle 48. See Column 4, Lines 41 - 55 of the Mitchell et al specification. As can be seen from comparing Figure 2 to Figure 3 of Mitchell et al, element 50 is movable between a position in which it is beneath the top surface of a working surface 12 (Figure 2) and above the top surface of the working surface 12 (Figure 3). Therefore, element 50 is not a housing mounted to an underside of the top surface of an article of furniture, as is expressly recited in independent Claim 19.

In view of the above, there is no strict identity of invention between the disclosure of the Mitchell et al patent and independent Claim 19 when all features of the claim are considered in the patentability evaluation. Applicant therefore

submits that independent Claim 19 is allowable over the only prior art reference applied to reject it in the final action. Dependent Claim 20 is allowable at least for the same reasons as parent independent Claim 19.

X. CONCLUSION:

For the reasons discussed herein, Applicant submits that all pending claims on appeal comply with 35 U.S.C. Section 112 in all respects, and are allowable over the prior art applied in the final action.

Applicant respectfully requests that the rejections of the claims made in the final action based both on 35 U.S.C. Section 112, and over the applied prior art, be reversed, and that the appealed Claims 1 - 20 to be allowed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Mark P. Stone", with a long horizontal flourish extending to the right.

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Washington, D.C. 20231

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APPENDIX OF APPEALED CLAIMS

Claim 1. In an article of furniture having a top surface and an opening defined in said top surface; the improvement comprising a receptacle unit adapted to be mounted in said opening in said top surface of said article of furniture; said receptacle unit comprising a top and at least one sidewall extending downwardly from said top, said at least one sidewall having at least one receptacle defined therein; and means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in which said at least one receptacle in said at least one sidewall of said receptacle unit is elevated above the top surface of said article of furniture.

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Claim 2. The improvement as claimed in Claim 1 wherein said receptacle unit is oriented and displaceable in a direction which is perpendicular to the top surface of said article of furniture.

Claim 3. The improvement as claimed in Claim 1 wherein said receptacle unit includes a plurality of sidewalls, each of said sidewalls having at least one receptacle therein, each of said sidewalls being recessed inwardly relative to the outer surface of the top of said receptacle unit.

Claim 4. The improvement as claimed in Claim 1 wherein said top of said receptacle unit and said opening in said top surface of said article of furniture are dimensioned such that a gap space is defined between an outer surface of the top of the receptacle unit and the top surface of said article of furniture when said receptacle unit is in its retracted position in said opening in said top surface.

Claim 5. The improvement as claimed in Claim 4 wherein said gap space is of sufficient dimension to permit a transmission line coupled to said receptacle unit to extend through said gap space when said receptacle unit is in its retracted position in said opening.

Claim 6. The improvement as claimed in Claim 1 further including means for resiliently biasing said receptacle unit into said extended position, and cooperating releasable locking means

for opposing said means for resiliently biasing for retaining said receptacle unit in said retracted position.

Claim 7. The improvement as claimed in Claim 4 further including means for at least partially covering said gap space between said receptacle unit and said top surface of said article of furniture to prevent articles from falling into said gap space when said receptacle unit is in said retracted position.

Claim 8. The improvement as claimed in Claim 7 wherein said means for covering includes a brush.

Claim 9. The improvement as claimed in Claim 7 wherein said means for covering includes a screen.

Claim 10. The improvement as claimed in Claim 7 wherein said means for covering is mounted to said top surface of said article of furniture and extends into said opening defined therein.

Claim 11. The improvement as claimed in Claim 7 wherein said means for covering is mounted to said top of said receptacle unit and is carried by said receptacle unit as it is displaced between said extended and retracted positions.

Claim 12. The improvement as claimed in Claim 1 wherein said receptacle unit has a plurality of sidewalls, each of said sidewalls carrying at least one receptacle.

Claim 13. The improvement as claimed in Claim 12 wherein said receptacle unit has a number of said sidewalls corresponding to the number of sides of said article of furniture, said receptacle unit being oriented relative to said sides of said article of furniture, such that a different sidewall of said receptacle unit faces a different side of said article of furniture.

Claim 14. The improvement as claimed in Claim 13 wherein said receptacle unit is generally rectangular shaped.

Claim 15. The improvement as claimed in Claim 13 wherein said receptacle unit is generally squared shaped.

Claim 16. An article of furniture having top surface and an opening defined in said top surface; a receptacle unit mounted in said opening in said top surface; said receptacle unit comprising a top and a plurality of sidewalls extending downwardly from said top; each of said sidewalls being recessed inwardly relative to the top of said receptacle unit; and means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in

which at least a portion of each of said plurality of sidewalls of said receptacle unit is elevated above the top surface of said article of furniture.

Claim 17. The article of furniture as claimed in Claim 16 wherein said article of furniture has a predetermined number of sides and said plurality of sidewalls of said receptacle unit are equal in number to the number of sides of said article of furniture, and said receptacle unit is oriented relative to said article of furniture such that each of said plurality of sidewalls of said receptacle unit faces a different one of said sides of said article of furniture.

Claim 18. The article of furniture as claimed in Claim 16 wherein said receptacle unit defines a periphery therearound, and said receptacle unit and said top surface of said article of furniture are oriented such that a gap is defined between the periphery of said receptacle unit and said top surface of said article of furniture when said receptacle unit is in said retracted position received in said opening in said top surface of said article of furniture.

Claim 19. An article of furniture having a top surface and an opening defined in said top surface; a receptacle unit mounted in said opening in said top surface; said receptacle unit comprising a top and at least one sidewall extending downwardly from said top, said at least one sidewall having at least one

receptacle defined therein; means for selectively displacing said receptacle unit between a retracted position in which said top of said receptacle unit is planar with said top surface of said article of furniture, and an extended position in which said at least one receptacle in said at least one sidewall of said receptacle unit is elevated above the top surface of said article of furniture; and a housing mounted to an underside of said top surface of said article of furniture, said housing having an open top and being aligned with said opening defined in said top surface of said article of furniture so as to receive said receptacle unit in said housing when said receptacle unit is in said retracted position.

Claim 20. The article of furniture as claimed in Claim 19 wherein said housing includes means for coupling said receptacle unit to an external power source.